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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/081,659
Filing Date: February 21, 2002
Appellant(s): MARISSETTY, SURESH K.

John Patrick Ward
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 21, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No claim amendment after final has been filed. Appellant has laid out the case history with regard to the various amendments. As noted on page 7 of the Brief, the Notice of Appeal was filed on April 21, 2004, along with another version of the reissue oath/declaration. An Advisory Action was issued on May 26, 2004, indicating that applicant's amendments would not be entered because they did not materially reduce or simplify the issues for appeal because the newly filed reissue oath/declaration is still faulty.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because while it is a general summary of the invention it appears to define the invention in somewhat broader terms than the specification itself. Column 3 of the patent as issued contains the Summary of the Invention which reads:

"A power management mechanism for use in a computer system is described. The computer system comprises a bus, a memory for storing data and instructions, and a central processing unit (CPU). The CPU runs an operating system having a power management virtual device driver (PMVxD) responsible for performing idle detection for devices. The PMVxD performs idle detection using event timers that provide an indicator as to the activity level. The PMVxD places idle local devices in a reduced power consumption state when no

activity has occurred for a predetermined period of time.”

See also the “Overview of the Present Invention” which bridges columns 4-5 of the originally issued patent.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. As noted in the appeal in the parent case, at least one of the issues presented does not really relate to the rejections made by the Examiner in the final Office Action. Specifically, appellant's issue 4 is directed to the propriety of the entire Recapture Doctrine and is not directed in particular to the claims in this case or directly to the rejections made in this case. Such an issue is directed to legal questions which seem to be beyond the scope of the appeal.

(7) *Grouping of Claims*

Appellant's Brief states that the claims stand or fall together. Although appellant has indicated that all of the independent claims stand or fall together and that the dependent claims are assumed to stand or fall with the independent claims on which they are dependent, arguments are made individually for each of the independent claims.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

First of all, the new reissue declaration filed December 29, 2003, appears to incorrectly state the limitations present in the patented claims. The new declaration indicates that "claims of the original patent are limited to a 'device manager.'" However the patented claims are actually limited much more than that to a virtual device driver, not merely to a "device manager." The original claims in the parent also included the limitations directed to a "device driver" which is itself a narrower limitation than "device manager." Since this limitation has been incorrectly stated in the declaration it is not clear that it can form the basis of the alleged error.

Secondly, the alleged error appears to go to the question of impermissible recapture which forms the basis of the rejection of the claims. On this point, should it be determined that impermissible recapture does not exist in this case, then the rejections based on a defective reissue declaration would be overcome. However, the first error noted above would still need to be corrected.

Furthermore, the reissue declaration should refer not only to the application as filed, but also to the various amendments which have been made in the application.

2. Claims 36-90 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 36-90 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As was noted in the previous action and in the parent case, the claims in this reissue application are broadened in a way that has resulted in an impermissible recapture of subject matter surrendered in the parent patent.

When determining whether recapture exists various test have been devised by the courts. The facts in Pannu and Clement appear to be most relevant to the facts in the present case. Those courts developed what are basically three part tests for determining whether or not recapture exists. First, did applicant broaden the claims; secondly, if so, is the broadening related to what was surrendered during prosecution of the patent; and third, have the claims also been materially narrowed. The Board in Ex parte Eggert basically reiterated this three part test, but went on to give some guidance regarding the third step of inquiry, namely that if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection, then impermissible recapture does not exist as long as

the replacement limitation provides a claim that is narrower than the subject matter "canceled" from the original application in order to overcome an art rejection.

The original or "surrendered" claim recites the use of a device driver for controlling power to various devices. The newly presented reissue claims do not include limitations drawn to the device driver or the virtual device driver limitation which was added in the amendment in order to make the patent claims allowable. Applicant freely added the "virtual" limitation to the claim and also argued it as the reason for allowability over the prior art. Even if only the original claim is what has been "surrendered", the claims in the reissue broaden even beyond that claim with respect to the fact that the reissue claims now only recite a power management module or program instructions for managing power consumption, and the device driver limitations are not present. Therefore, the claims are broader in that respect. So, with regard to the first part of the test, applicant's independent claims are broader than claim 11 of the patent.

Next, it is necessary to determine whether the broader aspect of the reissue claim is related to the surrendered subject matter. Applicant's original claim was rejected over the prior art to Smith and Stewart which showed a system with device drivers monitoring devices and controlling power to them. This rejection was overcome by adding the "virtual device driver limitation" to the claims. Therefore, the broadening removal of the device driver and virtual device driver limitations do broaden the claims in an aspect related to what was surrendered. The question then becomes whether or not the addition of power management module or instructions which control power to configurable devices is a material narrowing which avoids recapture.

It is submitted that the presence of the power management module or instruction limitations that measure the amount of time the processor has its clock stopped and reduce the voltage level applied to a processor as a result of the measuring in the reissue claims are not a

material narrowing of the surrendered subject matter with respect to the prior art rejection. The rejection was related to the use of a device driver for controlling power to devices. The reissue claims are broader in that respect as noted above. The fact that other limitations have been added that are not related to either the use of a device driver or virtual driver, that is to say, the addition of the limitation that the processor has its voltage reduced in response to the amount of time it has its clock stopped, is not a material narrowing germane to the prior art rejection.

Clement dealt with a similar issue in that the claims had been broadened with respect to the surrendered subject matter but had other narrowing limitations added. There the court found that recapture did exist because on balance the claims were broader than they were narrower in a manner directly related to the subject matter surrendered throughout prosecution. Clement at 1167. The same sort of situation exists in the present case.

Similarly, the facts in Pannu also seem to mirror those in the present case. **In the present case the addition of the time determining and voltage reducing limitations are not necessarily related to the use of a device driver for controlling power.** In Pannu the court found that, "The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning and dimensions of the snag resistant means." That court decided that this fact meant that, "The reissued claims were not narrowed in any material respect compared with their broadening." Such a statement also applies to reissue claims in the present case in that **any narrowing is with respect to the time determining and processor voltage reducing, not to the driver doing the controlling.** Therefore, it is believed that impermissible recapture exists with respect to the claims.

Using the analysis of Eggert, the replacement limitations do not provide a claim that is narrower than the canceled claim subject matter. **The replacement limitations are in fact broader than even the originally prosecuted claims because they eliminate the notion of**

a device driver altogether in addition to eliminating the virtual device driver limitation which was added to overcome the prior art rejection. Therefore, even in light of Eggert impermissible recapture exists in these claims.

(11) Response to Argument

Issue 1. Does the recapture doctrine bar any broadening of a claim beyond a limitation that was added to overcome a prior art rejection, meaning that the reissue claim may not exclude the precise limitation that was added to overcome prior art in the original patent?

In appellant's section A of this issue he lays out a lengthy discussion regarding case law related to recapture. The examiner makes no comment regarding this discussion and will instead focus on the claims in the reissue application that are the subject of this appeal.

Likewise, appellant's section B refers to the claims in the parent application which is also currently under appeal. Once again since no arguments are presented in this section related to the claims under appeal in the instant application there is nothing for the examiner to address.

In appellant's section C beginning on page 26 of the Brief arguments are presented regarding the claims under appeal in this application. With general reference to the independent claims appellant agrees that removal of "virtual device driver" is a broadening of the scope of the claims (Appellant's Brief page 26, lines 8-9). The examiner also submits that the claims are not only broader in scope than the issued claims with the "virtual device driver" limitation, **they are also broader than the originally filed claims which required a "device driver"**.

Appellant's claims under appeal in this case have removed limitations to both a "device driver" and a "virtual device driver".

Appellant goes on to argue that "since determining a power consumption state by determining an amount of time a clock is stopped, for example, is a specific function that **can** be performed by a virtual device driver, the claims are actually narrower in a manner material to the term 'virtual device driver'." (Appellant's Brief page 26, lines 12-15, emphasis added) Determining the amount of time the clock is stopped could also be measured by hardware timers or other software timers and it is not necessarily always associated with the operation of a virtual device driver or a device driver in general. The fact that the function **can** be performed by a virtual device driver does not mean that the function **is** performed by a virtual device driver.

Appellant's specification in col.5 describes the virtual device driver and its properties as:

"The present invention provides a power management VxD that controls at least a portion of the power management in the computer system. Power management in the present invention is facilitated by the I/O/interrupt/VxD trapping capabilities of the VxDs running in the protected mode of the CPU at the highest privileged level of the operating system in an operating system co-operative manner. The VxD operates at the CPU's highest privileged level (ring 0). Therefore, the VxD of the present invention has access and control over system hardware and software components. This enables it to operate and respond to power management events much faster, with low task switching overheads. In one embodiment, not only does the VxD interface to other software (e.g., applications), but it also provides an API interface to both real/protected mode programs."

Further, the website <http://whatis.techtarget.com> (an online dictionary of computing terms)

defines a virtual device driver as follows:

"In certain Microsoft operating systems, a virtual device driver is a program that handles software interrupts from the operating system (rather than hardware interrupts) for each of the computer's main hardware devices, including the hard disk drive controller, keyboard, and serial and parallel ports. A virtual device driver is used to maintain the status of a hardware device that has changeable settings."

Appellant also argues that "...what is materially limiting is best described in terms of potential infringers. A claim that merely recites the use of a 'virtual device driver' to detect an activity level of a processor as in claim 11, for example, would be able to be read on a much broader spectrum of alleged infringers than a claim limited to a specific manner in which an

activity level of a processor is to be detected." (Appellant's Brief page 26, lines 16-20) **However, in the claims under appeal there is no limitation directed to a virtual device driver or any device driver detecting the activity level. The specific way in which the activity level is determined is not related to the use of a virtual device driver or a device driver at all.**

Attention is directed to MPEP § 1412.02 (I)(C)(2)(a) on page 1400-19 of the May 2004 Revision which lays out rather clearly how to determine whether or not recapture exists in cases such as this. The section reads in pertinent part:

(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

Appellant basically is arguing that the limitations directed to determining a power consumption state by determining an amount of time a clock is stopped *are related* to the virtual device driver limitation. The examiner disagrees that such limitations are related to the virtual device driver limitation which applicant added to the claims and argued made them allowable over the prior art. It is important to note that the examiner in the parent case used the prior art references to Smith and Stewart to reject the original claims which were directed to using device drivers monitoring devices and controlling power to the devices. Appellant added the virtual device driver limitation and argued that this addition made the claims allowable by specifically agreeing with the examiner's statement of reasons for allowance. **The limitations directed to determining a power consumption state by determining an amount of time a clock is stopped are actually more narrow limitations with regard to the operation of the event timers recited in the original claims, not a narrowing with regard to the virtual device driver.** Claim 11 of the issued patent can be analyzed as in the example noted in the MPEP, where one can consider A to be the computer system with the bus and CPU, and B to be the device driver performing idle detection and placing an idle device in a reduced power

consumption state based on results from one or more event timers which event timers could be considered as an element C. Appellant added the "virtual device driver" limitation to overcome the prior art rejection which was a narrowing of element B. So we have a combination AB_{narrowed} C in the claims issued in the patent. Appellant's reissue claims are at most a combination AC_{narrowed}; where A is the general computer system and C_{narrowed} is the specific event timing limitation directed to determining a power consumption state by determining an amount of time a clock is stopped. The elimination of both the device driver (element B) and/or the virtual device driver (element B_{narrowed}) with no limitations introduced that are related to either of these limitations means that in this case impermissible recapture does exist.

With regard to appellant's second section C under issue 1 of the Brief beginning on page 27, appellant essentially argues that the examiner has not provided any basis for asserting that the limitations added to the reissue claims are not materially limiting. At the bottom of page 27 of the Brief, Appellant quotes a portion of page 5 of the Final Office Action but stops short of including the examiner's explanation of why the added limitations are not considered to be materially narrowing. As noted therein and above, the added limitations are not related to the device driver or virtual device driver but are directed to the processor having its voltage reduced in response to the amount of time it has its clock stopped which is not a material narrowing germane to the prior art rejection which was based on a system with a device driver detecting events and managing power to devices.

Appellant on page 28 of the Brief goes on to argue that the examiner concluded that Pannu simply precluded allowance of claims without the "virtual device driver limitation" and then again quotes a passage from page 5 of the Final Office Action but omits the previous sentence which gives the examiner's explanation regarding why the added limitations are not considered to be a material narrowing. That sentence reads: "In the present case the addition of

the time determining and voltage reducing limitations are not necessarily related to the use of a device driver for controlling power.” So the examiner has provided reasons why the added limitations are not material narrowing and has not simply made a blanket statement that the only reason for the impermissible recapture rejection is because the virtual device driver language is missing. The examiner has properly analyzed the reissue claims using the three step test for recapture set forth by the CAFC in Pannu and modified slightly by the Board in Ex Parte Eggert as outlined in MPEP § 1412.02.

On page 29 of the Brief appellant argues that the “current law does not prevent the applicant from removing language added in prosecution and modifying the scope of the claim in a manner pertinent to that amendment.” The examiner agrees with this statement insofar as it appears to be exactly what the Board concluded in Eggert, however, in the reissue claims in this case the scope of the claims has not been modified “in a manner pertinent to the amendment” and that is why impermissible recapture exists in this case as has been noted in the rejection and in the examiner’s arguments above.

Issue 2. Did applicant “surrender” any and all subject matter that lacks the “virtual device driver” limitation?

With regard to issue 2 appellant argues on pages 31 and 32 of the Brief that because none of the appellant's claims are equivalent in scope to the original and surrendered claim 11 that no recapture exists. However as noted in MPEP §1412.02 (I)(C) on page 1400-18 of the May 2004 Revision, lefthand column, second paragraph, “It is impermissible recapture for a reissue claim to be as broad **or broader** in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement*.” (emphasis added) It is

once again submitted that the claims in the reissue are in fact broader than the surrendered subject matter because not only has the virtual device driver limitation been removed but also the device driver limitation has also been omitted.

Appellant also appears to be attempting to argue on pages 31-33 of the Brief that there is no evidence that appellant's surrendered subject matter is related to the addition of the virtual device driver term to claim 11. However, appellant recognizes that an admission that the scope of the claim sought was not in fact patentable can occur by **either** (1) amending a claim; **or** (2) making statements that amount to an admission that a claim is unpatentable. (page 31, emphasis added). In this case there is no dispute that appellant amended claim 11 in the original application to add the term "virtual device driver" in place of the plain "device driver" limitation. This alone is enough to satisfy the admission requirement. However applicant further went on to agree with the examiner and reiterate that the addition of the term "virtual device driver" distinguished the claim over the prior art, as noted on page 25 of the Brief. This exact situation is discussed in MPEP §1412.02 (I)(B)(2) on page 1400-17, righthand column:

Scenario 1- There is Surrender: The examiner's statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y, in that limitation C provided increased speed to the process. Applicant filed comments on the examiner's statement of reasons for allowance essentially supporting the examiner's reasons. The limitation C is thus established as relating to subject matter previously surrendered.

In this case appellant added the virtual device driver limitation which could be called limitation C in this immediately above scenario, and also filed comments essentially supporting the examiner's reasons for allowance. Therefore the virtual device driver limitation is established as relating to subject matter previously surrendered.

Furthermore it is necessary to implement the third step of the recapture analysis as set forth in MPEP §1412.02 (I)(C) also beginning on page 1400-17 to determine which claims are to be compared to the reissue claims in determining the issue of surrender. On page 1400-18 the MPEP states:

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim 'fails' either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

(emphasis in the original)

As noted above the reissue claims are broader than at least claim 11 that was canceled or amended in the original prosecution to define over the art. Because the reissue claims "fail" on this analysis, impermissible recapture exists. However, the reissue claims also "fail" the second part of the analysis as well. MPEP page 1400-18 goes on to say:

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue

claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc.*, *supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

This analysis was basically discussed above regarding issue 1. The reissue claims entirely omit the limitation added and argued during the original prosecution to overcome the prior art rejection, i.e. the virtual device driver. The limitations directed to determining the amount of time the processor's clock is stopped are not related to the use of a virtual device driver which, as noted by the examiner in the parent patent, made the original claims allowable because a virtual device driver has no permanent tie to specific hardware, its use in controlling power to specific hardware is considered a novel departure from normal methods of power control. The new limitations in the reissue claims are not related to the virtual device driver but are instead directed to the operation of the event timers.

On page 34 of the Brief appellant argues that the examiner has misconstrued what applicant surrendered in the prosecution of the patent. However as the analysis above shows, the examiner has properly determined what appellant has actually surrendered. Appellant states that "the examiner repeatedly compares the newly proposed reissue claims to the issued claims containing the 'virtual device driver' limitation, not to the claims applicant gave up." However the

examiner has compared the claims to both the original claim as well as the issued patent claim throughout the recapture rejection analysis.

Issue 3. Does the recapture doctrine bar the independent claims?

On page 35 of the Brief appellant states, "As also discussed above, appellant contends that the term, "virtual device driver" in claim 11 as originally filed in the '342 patent constitutes the surrendered subject matter." This statement appears to be contradictory on a couple of levels since the term "virtual device driver" was not contained in claim 11 as it was originally filed and appellant seems to have spent the last several pages of the Brief arguing that the "virtual device driver" limitation is not what was surrendered.

Claim 36

With respect to claim 36, appellant argues on pages 37-38 of the Brief that the differences between patent claim 11 and reissue claim 36 are "material" in that the ways in which claim 36 are narrower than claim 11 are material. However, **Appellant admits on pages 37-38 of the Brief that "A 'virtual device driver' does not inherently provide the ability to determine an amount of time a processor is in a particular power consumption state. Nor does a device driver inherently possess the ability to detect whether a clock of the processor is stopped."** This is essentially the reason the examiner has stated for why these limitations are not materially related to the surrendered subject matter. It is the event timers that provide the ability to determine an amount of time a processor is in a particular power consumption state and they also seem to possess the ability to detect whether a clock of the processor is stopped. Therefore these limitations are not related to the virtual device driver or the device driver. **Appellant's own argument supports the examiner's position.** Appellant goes on to argue that "Claim 36, however, recites specific functions performed in specific ways

that could be performed by a virtual device driver.” However just because a virtual device driver **could** perform such functions does not necessarily mean that it does. **Furthermore it appears to be evident that it is not the virtual device driver or a device driver that performs these functions but rather the event timers which are used by the virtual driver that performs these functions.**

Appellant's claim 36 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and reducing a voltage level applied to the processor in response to the amount of time in the first state. The claim is much broader than either of those terms and merely recites a machine-readable medium having instructions stored thereon which if executed by a machine cause the machine to perform those operations. As such the scope is certainly broader than even the originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Claim 42

With respect to claim 42 appellant essentially makes the same arguments as those for claim 36. Appellant states that “the limitation pertaining to determining an amount of time the clock is stopped is a particular function that a device driver **could** carry out to monitor power consumption and therefore materially narrower than merely claiming a ‘virtual device driver’ to detect a processor ‘activity level’ as in claim 11.” (emphasis added). However just because a virtual device driver **could** perform such functions does not necessarily mean that it does. **Furthermore it appears to be evident that it is not the virtual device driver or a device**

driver that performs these functions but rather the event timers which are used by the virtual driver that performs these functions.

Appellant's claim 42 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and placing the processor in a reduced power mode. The claim is much broader than either of those terms and merely recites a machine-readable medium having instructions stored thereon which if executed by a machine cause the machine to perform those operations. As such the scope is certainly broader than even the originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Claim 49

Claim 49 is similar to claim 42 as noted by appellant on page 40. However, claim 49 is an apparatus claim which recites a power management module and a power reduction module that perform the operations recited in claim 42. **Once again claim 49 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and placing the processor in a reduced power mode. The claim is much broader than either of those terms and merely recites power management module and a power reduction module.** As such the scope is certainly broader than even the originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Claim 58

As noted by appellant claim 58 includes the limitations of claim 49 and also that the power reduction module comprises a software routine and the power management module comprises a timer. **Appellant also argues that the software is “much like a virtual device driver”, however software can and does take many forms and is a much broader term than “virtual device driver.” Once again claim 58 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and placing the processor in a reduced power mode.** The claim is much broader than either of those terms and merely recites power management module and a power reduction module. As such the scope is certainly broader than even the originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Claim 59

Claim 59 is quite similar to claim 49 as noted by appellant. It is also probably the most closely framed to patent claim 11 in that it recites a system comprising a memory coupled to a processor and a power management module to detect an amount of time the processor is in a first power state and the processor being placed in a reduced power state in response to the amount of time. **Once again claim 59 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and placing the processor in a reduced power mode. The claim is much broader than either of those terms and merely recites power management module and a power reduction module.** As such the scope is certainly broader than even the

originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Claim 77

Appellant notes that claim 77 is a method comprising operations that may be carried out by the apparatus of claim 49 or the system of claim 59. **Once again claim 77 is limited to neither a device driver nor a virtual device driver for determining the amount of time the processor is in a first power state in which the clock is stopped, and placing the processor in a reduced power mode.** The claim is much broader than either of those terms and merely recites power management module and a power reduction module. As such the scope is certainly broader than even the originally filed claim 11 in the patent. Because the claim has been broadened in a way directly related to what was surrendered in the original prosecution and no materially narrowing limitations have been added, impermissible recapture exists.

Issue 4. Is the Judicially Created Recapture-Doctrine inherently and irreconcilably inconsistent with the Reissue Statute, 35 USC § 251, which permits broadening of claims, and now devoid of its original purpose of ensuring comity to the prosecution-history-reading public?

As noted above, this is not really an issue in itself to be decided in this appeal since it is not directed to the rejections contained in the Final Office Action. The arguments presented in this section of the Brief are legal arguments for the courts to decide and appear to be beyond the scope of this appeal. The examiner has applied the three step test for determining whether

recapture exists as set forth in MPEP § 1412.02 which is based on the applicable case law and Board decisions.

Issue 5. Is the Failure of an Attorney to Appreciate the Scope of the Invention

Sufficient Error upon which the Applicant may rely as a Basis for a Broadening

Reissue?

Appellant argues that there is no requirement in the Rules, MPEP, or case law that a specific error be cited in the reissue oath or declaration. Appellant argues that it is sufficient for the reissue declaration to say that the error is the attorney's failure to appreciate the scope of the invention and that it is not necessary to identify any particular claim language or part of the specification. The examiner, after numerous consultations with the Tech Center's Special Programs Examiners (SPRE's), has maintained that it is a requirement as stated in the MPEP that appellant set forth a specific error referring to claim language which renders the patent wholly or partly inoperative or invalid. Attention is directed to 37 CFR §1.175(a)(1) which says that the reissue declaration must state that:

"The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue". (emphasis added)

As pointed out by the examiner many times and as contained in the Final Office Action, MPEP §1414(II)(C) states that "Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error." Since appellant is basically saying that the claims in the patent are not of the appropriate scope for his invention, and that this is the result of the attorney's failure to appreciate the scope of the invention, it would appear that the "error" that is the basis of the reissue is an error in the claims. As noted it is sufficient to

identify a single error in a single claim. However, in identifying the error appellant must identify specifically what the error is, as indicated above with reference to MPEP §1414(II).

Appellant points out that on page 1400-2 of the MPEP there is an indication that an attorney's failure to appreciate the scope of the invention was held to be a correctable error. This is certainly not disputed. However, as noted above such a failure to appreciate the scope of the invention indicates that the claims in the patent are either too broad or too narrow, which means that the error being corrected by reissue lies in the claims. And since the error lies in the claims the specific claim language which is in error must be identified as noted in MPEP §1414(II). The examiner is not requiring that appellant to point out how or when the error arose or when it was discovered as was the case in past practice. The examiner is merely requiring that appellant specify what it is in the claims that renders them to be wholly or partly inoperative or invalid as required in the MPEP.

As noted in the Advisory Action of May 26, 2004, the reissue declaration filed along with the Notice of Appeal is in compliance with the Rules and the MPEP's requirements related to the identification of an error. However the phrase "without deceptive intention on my part" is insufficient. The language should read "without deceptive intention on the part of the applicant" because this language encompasses not only the inventor but also his attorneys and assigns.

For the above reasons, it is believed that the rejections should be sustained.

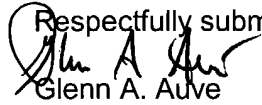
Application Number: 10/081,659

24

Art Unit: 2111

Examiner's Answer

Respectfully submitted,



Glenn A. Auve
Primary Examiner
Art Unit 2111

gaa

August 5, 2004

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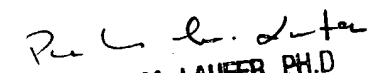
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